



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|----------------------------|
| 10/021,197 | 11/29/2001 | Janine L. Delapass | 014208.1420 (65-01-001) | 9466 |
| 7590 | 07/14/2004 | | | |
| Baker Botts L.L.P. Suite 600 2001 Ross Avenue Dallas, TX 75201-2980 | | | | EXAMINER LANEAU, RONALD |
| | | | ART UNIT 3627 | PAPER NUMBER |

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/021,197 | DELAPASS ET AL. <i>[Signature]</i> | |
| | Examiner | Art Unit | |
| | Ronald Laneau | 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 November 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1-25 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 12-14, 18, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Parkan, Jr (US 2003/0061131).

As per claims 1, 12, 14, 18, and 22, Parkan, Jr teaches a system and method for calculating tax credit information (page 2, [0023], lines 33-39) comprising: providing an on-line reporting form to a plurality of users (page 5, [0042], lines 8-14, [0043], lines 12-14); collecting from more than one of the plurality of users, information regarding allocation of financial resources regarding one or more projects associated with the more than one of the plurality of users (page 5, [0044], lines 10-15); and calculating tax credit information based upon the allocation of financial resources regarding the one or more projects (page 5, [0025], lines 1-27).

As per claim 13, Parkan, Jr teaches a method comprising generating a tax return form indicating a cumulative tax credit amount wherein the tax return form is in compliance with Internal Revenue Service codes (page 1, [0002], lines 1-4).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-4, 9, 10, 15, 16, 19, 20, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parkan, Jr (US 2003/0061131) in view of Sullivan (US 2003/0093320).

As per claims 2, 4, 15, 19, and 23, see rejection of claims 1, 14, 18, and 22. Parkan, Jr does not teach verifying the information by comparing the information with stored data within one or more databases but Sullivan teaches verifying from time-to-time the addresses in the seller and/or purchaser databases (page 11, [0095], lines 5-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the information verification process as taught by Sullivan in to the device of Parkan, Jr because it would allow tax authorities to provide and monitor the transaction tax information to a certain extent by verifying some of the information inputted from a stored database.

As per claims 3, 16, 20, and 24, see rejection of claims 1, 14, 18, and 22. Parkan, Jr does not teach performing one or more editing checks regarding the information and verifying that related data fields do not contain inconsistent data but Sullivan teaches a system wherein users of the transaction tax compliance 200 may enter or edit contact information, company information, headquarters, etc (page 2, [0040], lines 1-8), and

verifying from time-to-time the addresses in the seller and/or purchaser databases (page 11, [0095], lines 5-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the editing of information and the information verification process as taught by Sullivan in to the device of Parkan, Jr for the same reasons given in claims 3, 16, 20, and 24.

As per claims 9 and 10, see rejection of claims 1, 14, 18, and 22. Parkan, Jr does not teach batch producing hard copy printouts of the on-line reporting form as claimed but Sullivan teaches a system which imports all tax information into the applicable tax return and wherein the returns can be completed and printed for execution and mailing (page 1, [0006], lines 11-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the printout as a backup documentation as taught by Sullivan into the device of Parkan, Jr because it would allow the tax authorities to have the information handy in case of a system failure.

6. Claims 5-8, 11, 17, 21, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parkan, Jr (US 2003/0061131) in view of Sullivan (US 2003/0093320) and further in view of Brady (US 6,633,875).

As per claims 5-8, 11, 17, 21, and 25, the combination of Parkan, Jr and Sullivan do not teach an SQL database to retrieve data associated with the on-line reporting but Brady teaches an SQL database 20 capable of validating data, reporting information (producing or generating report) as claimed (fig. 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the SQL database as taught by Brady into the combined device because it would generate reports from the information stored in the database without the need for manual processing and confidentiality of the data. (col. 2, lines 10-16).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Morano et al (US 2004/0078271) teach a system and method for tax reporting of taxable and non-taxable distributions, gains and losses of investments including providing access to tax information regarding the investments and providing various functions pertaining to the tax information.
- Foster (US 2004/0024665) teaches a method and a system for determining taxes attributable to a financial transaction.
- Francisco et al (US 5,799,283) teach a point of sale tax reporting and automatic collection system.
- Francisco et al (US 6,078,899) teach a point of sale tax reporting and automatic collection system.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald Laneau
Examiner
Art Unit 3627

rl

Michael Cuff 7/12/04
MICHAEL CUFF
PRIMARY EXAMINER